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IN THE UNITED STATES PATENT OFFICE

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In re Application of Klimko et al.



48
9/21/98
MW

Serial No. 08/917,795

Filed: August 21, 1997

Examiner: R. Raymond

Group Art Unit: 1611

**For: Use of Cloprostenol and Fluprostenol Analogues
To Treat Glaucoma and Ocular Hypertension**

TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(b) and (c)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Alcon Laboratories, Inc. ("Alcon") is the owner of the entire interest in the above-identified patent application and related United States Patent Nos. 5,510,383 (issued April 23, 1996) and 5,665,773 (issued September 9, 1997), as demonstrated by the attached assignment documents and notices of recordation for application Serial No. 08/917,795. The present application, the '773 patent, and the '383 patent are derived from USSN 08/101,598 filed on August 3, 1993 (now abandoned).

Alcon hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent No. 5,510,383 (referred to hereinafter as the prior patent). Alcon hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs

with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Alcon does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that the prior patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the Untied States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

ALCON LABORATORIES, INC.

Date 9-15-88

By Barry L. Copeland

Barry L. Copeland

Registration No. 34,801

ADDRESS FOR CORRESPONDENCE:

Barry L. Copeland [Mail Code Q-148]
Intellectual Property Law & R&D Counsel
ALCON LABORATORIES, INC.
6201 South Freeway
Fort Worth, Texas 76134-2099
Phone: (817) 551-4322
Attorney Docket No.: 1407B



DATE: 10/20/94
TO:

N12B

JULIE J. L. CHENG
PATENT DEPT., MC Q-148
ALCON LABORATORIES, INC.
6201 SOUTH FREEWAY
FORT WORTH, TX 76134-2099

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT ASSIGNMENT PROCESSING SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT BRANCH, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

ASSIGNOR: KLIMKO, PETER G. DOC DATE: 07/26/94

ASSIGNOR: BISHOP, JOHN E. DOC DATE: 07/26/94

ASSIGNOR: SALLEE, VERNEY L. DOC DATE: 07/26/94

RECORDATION DATE: 09/21/94 NUMBER OF PAGES 004 REEL/FRAME 7143/0817

DIGEST : ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE:
ALCON LABORATORIES, INC.
PATENT DEPARTMENT, MC Q-148
6201 SOUTH FREEWAY
FORT WORTH, TX 76134-2099

SERIAL NUMBER 8-280681 FILING DATE 07/26/94
PATENT NUMBER ISSUE DATE 00/00/00

Julie K. Cheng
EXAMINER/PARALEGAL
ASSIGNMENT BRANCH
ASSIGNMENT/CERTIFICATION SERVICES DIVISION

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof

1. Name of conveying party(ies):

Peter G. Klimko
John E. Bishop
Verney L. Sallee

Additional name(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

Assignment
 Security Agreement
 Other

Merger
 Change of Name

Execution Date: July 26, 1994

Address of receiving party(ies):

Name: Alcon Laboratories, Inc.Internal Address: Patent Department, MC Q-148Street Address: 6201 South FreewayCity: Fort Worth State: TX ZIP: 76134-2099Additional name(s) & address(es) attached? Yes No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

08/280,681

B. Patent No.(s)

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Julie J. L. ChengInternal Address: Patent Dept., MC Q-148ALCON LABORATORIES, INC.Street Address: 6201 South FreewayCity: Fort Worth State: TX ZIP: 76134-2099

6. Total number of applications and patents involved:

17. Total fee (37 CFR 3.41).....\$ 40.00 Enclosed Authorized to be charged to deposit account

8. Deposit account number:

01-0682

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

TW11454 10/03/94 08280681

0 - 0482 110 591

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Julie J. L. Cheng
Name of Person Signing

Signature

Date

9/16/94Total number of pages including cover sheet
one (1)

CMB No. 0651-0011 (exp. 4/94)

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Box Assignments
Washington, D.C. 20231

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ASSIGNMENT

WHEREAS I am a below named inventor of the invention entitled:

**"USE OF CLOPROSTENOL AND FLUPROSTENOL ANALOGUES
TO TREAT GLAUCOMA AND OCULAR HYPERTENSION "**

and described in a United States Patent Application filed with the United States Patent and Trademark Office on July 26, 1994, and further identified by Attorney Docket No. **1407**.

WHEREAS, ALCON LABORATORIES, INC., a company organized under the laws of Delaware and having a place of business at 6201 South Freeway, Fort Worth, Texas, 76134, is desirous of acquiring the entire right, title and interest in and to said invention and to any and all Letters Patent of the United States and foreign countries which may be obtained therefor;

NOW, THEREFORE, for good and valuable consideration, I do hereby sell, assign and transfer to ALCON LABORATORIES, INC., its legal representatives, successors, and assigns, the entire right, title and interest in and to said invention as set forth in the above-mentioned application, and in and to any and all patents of the United States and foreign countries which may be issued for said invention;

UPON SAID CONSIDERATIONS, I hereby agree that I will not execute any writing or do any act whatsoever conflicting with these presents, and that I will, at any time upon request, without further or additional consideration but at the expense of said assignee, execute such additional assignments and other writings and do such additional acts as said assignee may deem necessary or desirable to perfect the assignee's enjoyment of this grant and render all necessary assistance in making application for and obtaining original, divisional, reexamined, reissued, or other Letters Patent of the United States or of any and all foreign countries on said invention and in enforcing any rights in action accruing as a result of such applications or patents, said assistance to include my cooperation in all

prosecution associated with obtaining such applications or patents and my provision of testimony in any proceedings or transactions involving such applications or patents, it being understood that the foregoing covenant and agreement shall bind, and inure to the benefit of, the assigns and legal representatives of assignor and assignee.

AND I request the Commissioner of Patents and Trademarks to issue any Letters Patent of the United States which may be issued for said invention to said ALCON LABORATORIES, INC., its legal representatives, successors or assigns, as the sole owner of the entire right, title and interest in said patent and the invention covered thereby.

Full name of inventor:

Peter G. Klimko

Inventor's Signature:

Peter G. Klimko

Date:

7/22/94

Residence/Post Office Address:

5301 Overton Ridge, #1206

Ft. Worth, Texas 76132

Citizenship:

United States

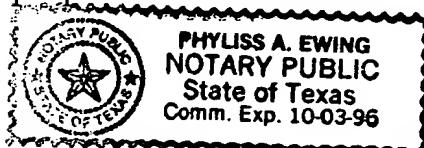
STATE OF TEXAS \$

\$

COUNTY OF TARRANT \$

\$

On this 2nd day of July 1994 before me personally appeared Peter G. Klimko, to me known to be the person named in and who executed the above instrument, and acknowledged to me he executed the same for the uses and purposes therein set forth.



Phyllis A. Ewing
Notary Public

Full name of inventor:

John E. Bishop

Inventor's Signature:

John E. Bishop

Date:

22 July 1994

Residence/Post Office Address:

18 Chadwick Circle, Apt. B

Nashua, New Hampshire 03062

Citizenship:

United States

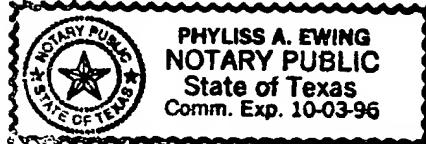
STATE OF TEXAS \$

\$

COUNTY OF TARRANT \$

\$

On this 22nd day of July 1994 before me personally appeared John E. Bishop, to me known to be the person named in and who executed the above instrument, and acknowledged to me he executed the same for the uses and purposes therein set forth.



Phyli A. Ewing
Notary Public

Full name of inventor:

Verney L. Sallee

Inventor's Signature:

Verney L. Sallee

Date:

July 29, 1994

Residence/Post Office Address:

304 Diamond Lane

Burleson, Texas 76023

Citizenship:

United States

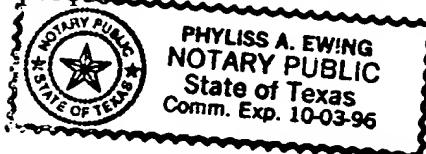
STATE OF TEXAS \$

\$

COUNTY OF TARRANT \$

\$

On this 25th day of July 1994 before me personally appeared Verney L. Sallee, to me known to be the person named in and who executed the above instrument, and acknowledged to me he executed the same for the uses and purposes therein set forth.



Phyli A. Ewing
Notary Public RECORDED
PATENT AND TRADEMARK
OFFICE



UNITED STATES DEPARTMENT OF COMMERCE

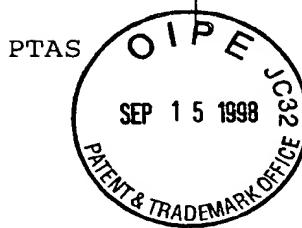
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JUNE 06, 1997

ALCON LABORATORIES, INC.
BARRY L. COPELAND
PATENT DEPARTMENT (Q-148)
6201 SOUTH FREEWAY
FORT WORTH, TX 76134-2099

PTAS



100403899A

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 04/25/1997

REEL/FRAME: 8467/0681

NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNEE'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNEE:

ZINKE, PAUL W.

DOC DATE: 04/21/1997

ASSIGNEE:

ALCON LABORATORIES, INC.
6201 SOUTH FREEWAY
FORT WORTH, TEXAS 76134

SERIAL NUMBER: 08769293

FILING DATE: 12/18/1996

PATENT NUMBER:

ISSUE DATE:

KEITH GOODE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

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JUN 16 1997

PATENT & T

04-29-1997

FORM PTO-1595
1-31-92

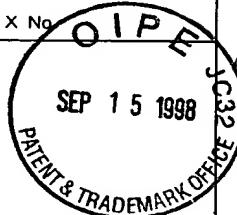
To the Honorable Commissioner

100403899

1. Name of conveying party(ies): **Paul W. Zinke**Additional name(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

Assignment Merger
 Security Agreement Change of Name
 Other _____

Execution Date: **April 21, 1997**A COVER SHEET
ONLYU.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

APR 25 1997

original documents or copy thereof

2. Name and address of receiving party(ies):

Name: **Alcon Laboratories, Inc..**Address: **6201 South Freeway
Fort Worth, Texas 76134**Additional name(s) & address(es) attached? Yes No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

08/769,293

B. Patent No.(s)

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: **Barry L. Copeland**Internal Address: **Patent Department (Q-148)****ALCON LABORATORIES, INC.**Street Address: **6201 South Freeway**City: **Fort Worth** State: **TX** ZIP: **76134-2099**

6. Total number of applications and patents involved:

one (1)7. Total fee (37 CFR 3.41).....\$ **40.00** Enclosed

X Authorized to be charged to deposit account

8. Deposit account number:

01-0682

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Barry L. Copeland
Name of Person Signing

Reg. No. 34,801

4-24-97
DateTotal number of pages including cover sheet **3**

Docket 1560

CMB No. 0651-0011 (exp. 4/94)

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ASSIGNMENT

WHEREAS I am a below named inventor of the invention entitled:

USE OF CLOPROSTENOL AND FLUPROSTENOL ANALOGUES TO TREAT GLAUCOMA AND OCULAR HYPERTENSION

and described in a United States Patent Application filed with the United States Patent and Trademark Office on December 18, 1996, Serial No. 08/769,293 and further identified by Attorney Docket No. 1407A; and

WHEREAS, ALCON LABORATORIES, INC., a company organized under the laws of Delaware and having a place of business at 6201 South Freeway, Fort Worth, Texas, 76134, is desirous of acquiring the entire right, title and interest in and to said invention and to any and all Letters Patent of the United States and foreign countries which may be obtained therefor;

NOW, THEREFORE, for good and valuable consideration, I do hereby sell, assign and transfer to ALCON LABORATORIES, INC., its legal representatives, successors, and assigns, the entire right, title and interest in and to said invention as set forth in the above-mentioned application, and in and to any and all patents of the United States and foreign countries which may be issued for said invention;

UPON SAID CONSIDERATIONS, I hereby agree that I will not execute any writing or do any act whatsoever conflicting with these presents, and that I will, at any time upon request, without further or additional consideration but at the expense of said assignee, execute such additional assignments and other writings and do such additional acts as said assignee may deem necessary or desirable to perfect the assignee's enjoyment of this grant and render all necessary assistance in making application for and obtaining original, divisional, continuation-in-part, reexamined,

reissued, or other Letters Patent of the United States or of any and all foreign countries on said invention and in enforcing any rights in action accruing as a result of such applications or patents, said assistance to include my cooperation in all prosecution associated with obtaining such applications or patents and my provision of testimony in any proceedings or transactions involving such applications or patents, it being understood that the foregoing covenant and agreement shall bind, and inure to the benefit of, the assigns and legal representatives of assignor and assignee.

AND I request the Commissioner of Patents and Trademarks to issue any Letters Patent of the United States which may be issued for said invention to said ALCON LABORATORIES, INC., its legal representatives, successors or assigns, as the sole owner of the entire right, title and interest in said patent and the invention covered thereby.

Full name of inventor:

PAUL W. ZINKE

Inventor's signature:

Paul W. Zinke

Date:

April 21, 1997

Residence and Post Office

4129 Willow Way Road

Address:

Fort Worth, Texas 76133

Citizenship:

United States

STATE OF TEXAS

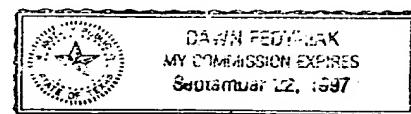
§
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COUNTY OF TARRANT

On this 21 day of April, 1997, before me personally appeared PAUL W. ZINKE, to me known to be the person named in and who executed the above instrument, and acknowledged to me he/she executed the same for the uses and purposes therein set forth.

DAWN FEDYMIK
Notary Public

Atty Docket 1407A



SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 9-24-98

APPL. S.N.: 081917795

TO EXAMINER: R. Raymond

ART UNIT: 1611

M. MINTGOMERY ROOM 1018

MAILROOM DATE 9-15-98

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE IN LEFT IN FILE.

The T.D. is PROPER and has been recorded. (See 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

Application Examiner has not processed T.D. fee. (See fee authorization).

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity. (See 14.28).

Is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.01).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

Other: _____

Suggestion to request refund of \$ _____ . (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- Sample of a TD over a pending application and assignee Certificate (See 14.37).
- Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)